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09/882,292	06/15/2001	Laura T. Putnam	2709/113	6870
2101 7590 03/16/2010 Sunstein Kann Murphy & Timbers LLP 125 SUMMER STREET BOSTON, MA 02110-1618			EXAMINER BOYCE, ANDRE D	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* LAURA T. PUTNAM, EILEEN C. SHAPIRO,
9 and STEVEN J. MINTZ
10

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12 Appeal 2009-001096
13 Application 09/882,292
14 Technology Center 3600
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17 Decided: March 16, 2010
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21 *Before* MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU
22 R. MOHANTY, *Administrative Patent Judges*.
23
24 CRAWFORD, *Administrative Patent Judge*.
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26

27 DECISION ON REQUEST FOR REHEARING

Laura T. Putnam et al. (Appellants) have filed a Request for Rehearing (hereinafter “Request”) under 37 C.F.R. § 41.52 (2009), requesting that we reconsider our Decision of August 27, 2009 (hereinafter “Decision”), wherein we reversed the rejection of claims 3-6, 8-12, 14, 15, 17, 19, 21, 23, 24, 28-30, 34-38, 40, 42, 43, 45, 47, 49, 51, 53-55, 59, 61, 80-102, 104, 105, 111, 112, 118, and 119 (hereinafter “reversed claims”) under 35 U.S.C. § 102(b) (2002) and entered a new ground for rejecting claims 7, 13, 16, 18, 20, 22, 25-27, 31-33, 39, 41, 44, 46, 48, 50, 52, 56-58, 60, 62, 106-110, 113-117, and 120-124 (hereinafter “affirmed claims”) under 35 U.S.C. § 103(a) (2002). The Appellants argue that (1) the Decision is internally inconsistent such that our Decision “suggests that at least independent claims 3, 80, and 88 are rejected as being obvious under a new ground of rejection” (Request 1) and (2) the panel has misapprehended correlation of industries with respect to job function capability as recited in independent claims 3, 80, and 88 (Request 2-3).

The Request for Rehearing is GRANTED-IN-PART.

DISCUSSION

For argument (1), we modify our Decision and enter a new ground of rejection, under 37 C.F.R. § 41.50(b), for independent claims 3, 80, and 88 as being unpatentable under 35 U.S.C. § 103(a) in view of Salmon. Specifically, as set forth on pages 5-6 of our Decision, Salmon does not disclose accessing a *database* that correlates, for a job function, a first industry with a set of second industries with respect to which the job function capability is potentially transferable, as recited in independent claims 3, 80, and 88. However, Salmon does disclose that a *user* creating a

1 Buyer Profile correlates a candidate with multiple industries by weighting
2 industry and experience. One of ordinary skill in the art would have found it
3 obvious to automate, via the database, the above-referenced correlating
4 process performed by the user in order to gain the commonly understood
5 benefits of such adaptation, such as saving the user the time spent creating
6 the weightings in the Buyer Profile. *See Leapfrog Enterprises, Inc. v.*
7 *Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

8 With regard to argument (2), Appellants first assert that the Board
9 misapprehended Salmon because Salmon does not “identify[] industries
10 where a type of experience in one industry is transferable to another type of
11 experience in another industry” (Request 2). Specifically, Salmon does not
12 satisfy the scenario where for a search for someone with sales experience in
13 electronics, “Salmon’s system might match a candidate who has sales
14 experience in an irrelevant industry (e.g., farming products) and yet fail to
15 match a candidate who lacks sales or marketing experience but has
16 transferable experience in another industry” (Request 2). However, such a
17 requirement that Salmon needs to meet such a scenario is not set forth in the
18 claims. *See CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231
19 (Fed. Cir. 2005). Put simply, the Appellants have not set forth in the claim
20 the difference between “experience” and the criteria that determines a
21 “relevant” or “irrelevant” industry. Accordingly, they are assumed to be one
22 and the same under a broadest reasonable construction of “job function.”
23 *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

24 All independent claims 3, 80, and 88 recite is correlating potentially
25 transferable job functions for two industries. By setting the weights of
26 industry and experience in Salmon, the user is implicitly stating how much a

1 particular experience or “job function” is transferable across industries. For
2 example, if the particular “experience” is weighted high and the particular
3 “industry” is weighted low, then the job function is potentially transferable
4 across several industries, thus meeting the claim recitations. While
5 Appellants disparage the “administrative assistant” method of screening
6 candidates, such a method, with automation, does meet the present claim
7 recitations.

8 Appellants also identify several advantages of the claimed invention.
9 However, such advantages are not set forth in the claims. *See CollegeNet,*
10 *Inc. v. ApplyYourself, Inc.*, 418 F.3d at 1231.

11 Appellants also assert that “the presently claimed invention satisfies a
12 long-felt need.” However, no evidence of such long-felt need is provided.
13 *See In re Schulze*, 346 F.2d 600, 602 (CCPA 1965).

14 Appellants further assert that “the apparent goal of Salmon is to
15 ensure that a particular subject is not considered for a particular job unless
16 the subject already has experience with that job in the relevant industry, and
17 so Salmon actually teaches away from the claimed invention.” However,
18 teaching away has to do with inoperability rather than undesirability. *See In*
19 *re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). Clearly the system of Salmon
20 can handle a user altering the weights for experience and industry, i.e., the
21 database will not cease functioning when the weights are altered to capture a
22 person/job that Salmon finds undesirable. Thus, there is no teaching away.

23 Moreover, the options for weighting experience and industry are
24 limited; they can either be weighted toward or away from what is desired by

1 Salmon. Accordingly, in view of such a finite number of options, even a
2 variation away from what is desired by Salmon is obvious. *See KSR Int'l*
3 *Co. v. Teleflex Inc.*, 550 U.S. 398, 402-03 (2007).

4
5 DECISION

6 We have considered Appellants' Request for Rehearing, and modify
7 our Decision to the extent set forth herein. With respect to all other issues,
8 the Request for Rehearing is denied.

9
10 TIME PERIOD FOR RESPONSE

11 In addition to affirming the Examiner's rejection of one or more
12 claims, this decision contains a new ground of rejection pursuant to 37
13 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960
14 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37
15 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this
16 paragraph shall not be considered final for judicial review."

17 37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN
18 TWO MONTHS FROM THE DATE OF THE DECISION, must exercise
19 one of the following two options with respect to the new ground of rejection
20 to avoid termination of the appeal as to the rejected claims:

21 (1) *Reopen prosecution.* Submit an appropriate amendment of the
22 claims so rejected or new evidence relating to the claims so rejected,
23 or both, and have the matter reconsidered by the Examiner, in which
24 event the proceeding will be remanded to the Examiner....

25 (2) *Request rehearing.* Request that the proceeding be reheard under
26 § 41.52 by the Board upon the same record....

Should the Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REHEARING GRANTED-IN-PART; 37 C.F.R. § 41.50(b)

hh

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